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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,663	01/22/2004	John E. Tadych	ABR-32112 5153 EXAMINER	
22202	7590 09/18/2006	·		
WHYTE HIRSCHBOECK DUDEK S C			MULCAHY, PETER D	
SUITE 1900	555 EAST WELLS STREET SUITE 1900			PAPER NUMBER
MILWAUKEE, WI 53202			1713	
			DATE MAILED: 09/18/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
Office Action Summers	10/762,663	TADYCH, JOHN E.			
Office Action Summary	Examiner	Art Unit			
The MAN INC DATE And	Peter D. Mulcahy	1713			
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address			
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period w  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION  16(a). In no event, however, may a reply be ting  17 apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D. (35 U.S.C. \$ 133)			
Status					
1)⊠ Responsive to communication(s) filed on 10 Ju	<u>ly 2006</u> .				
	)☐ This action is <b>FINAL</b> . 2b)⊠ This action is non-final.				
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 4	53 O.G. 213.			
Disposition of Claims					
4)⊠ Claim(s) <u>1,2 and 8-15</u> is/are pending in the application.					
4a) Of the above claim(s) is/are withdrawn from consideration.					
5) Claim(s) is/are allowed.					
6)⊠ Claim(s) <u>1,2 and 8-15</u> is/are rejected.					
7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or	alastian ramiinamant				
are subject to restriction and/or	election requirement.				
Application Papers					
9)☐ The specification is objected to by the Examiner					
10) The drawing(s) filed on is/are: a) acce					
Applicant may not request that any objection to the o					
Replacement drawing sheet(s) including the correcti					
11) The oath or declaration is objected to by the Ex	ammer, Note the attached Office	Action of form PTO-152.			
Priority under 35 U.S.C. § 119					
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).					
a) All b) Some * c) None of:					
1. Certified copies of the priority documents have been received.					
<ul><li>2.  Certified copies of the priority documents</li><li>3.  Copies of the certified copies of the priori</li></ul>					
application from the International Bureau		ed in this National Stage			
* See the attached detailed Office action for a list of the certified copies not received.					
	,				
Attachment(s)					
1) Notice of References Cited (PTO-892)	4) Interview Summary				
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08)	Paper No(s)/Mail Da 5) Notice of Informal P				
Paper No(s)/Mail Date	6) Other:	• •			

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## **DETAILED ACTION**

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## Claim Rejections - 35 USC § 103

- 1: The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 2. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  - 1. Determining the scope and contents of the prior art.
  - 2. Ascertaining the differences between the prior art and the claims at issue.
  - 3. Resolving the level of ordinary skill in the pertinent art.
  - 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- 3. Claims 1,2 and 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. US 6,929,857.
- 4. This patent shows rubber compositions based on vulcanized rubber latex ingredients, see column 3 line 51 where the vulcanizing agents are suggested. The claimed rubber latex is discussed at column 4 lines 10+. The filler ingredient is suggested at column 3 line 52 and column 6 lines 35+. The aqueous ammonia component is suggested at column 4 lines 5-6 and exemplified at column 9 line 64 and column 10 line 24. These examples are considered to be the closest teaching with respect to the claimed invention. Here the rubber latex is shown in combination with the aqueous ammonia. The incorporation of the filler is not exemplified in these examples.

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The fillers are suggested in the disclosure of this patent as referenced *supra*. It would be obvious to incorporate the fillers suggested in the disclosure in these examples given that the fillers are suggested in the disclosure and one of ordinary skill would have a reasonable expectation of the result.

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- 5. It is acknowledged that the claims recite a "masking compound." The art is silent as to this use of the compound. This is not considered a patentable distinction.

  Moreover, "masking compound" is not seen to significantly limit the claimed compound. This is a use limitation in the preamble. It has no significant structure limitations. Case law has well established that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The compounds of the art are clearly "capable" of functioning as a masking compound. As such, this limitation is anticipated.
- 6. Further, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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## Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

> Peter D. Mulcahy **Primary Examiner**

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